

## **REMARKS**

Claim 81 has been amended to conform to the form of previously amended claim 92. Applicants' amendment does not raise any new issues requiring a new search, and requires only a cursory review in view of Applicant's previous amendment to claim 92 of "at least about 1 weight percent of inorganic salt", which was not rejected under 35 U.S.C. § 112. Claims 81-100 and 111-122 are pending in the present application.

### **Rejections under 35 U.S.C. § 112**

Claims 88, 89, 99 and 100 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, there is no disclosure directed to a peel force between the wipes in the roll in the claimed amounts. In particular, the Examiner states that "[t]he original disclosure is directed to an amount of 'at least about 100 grams' for peel force between wipes." Applicants respectfully disagree in view of multiple references in the application and claims reciting "a peel force between the wipes of at least 100 g" and original claims depending therefrom reciting "a peel force between the spiral wraps of the roll of at least 115 g" or reciting "a peel force between the spiral wraps of the roll of from about 106g to about 170 g" (see e.g., original claims 1, 8 and 9). Recitation of peel forces between spiral wraps in the original claims depending from "wet wipes having a peel force between the wipes of at least 100 g" evidences the recited spiral wrap peel forces applying to peel forces between wet wipes as recited in the independent claims.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

### **Rejections under 35 U.S.C. § 112**

Claims 111 and 112 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in their recitation of the term "about 1", described by the examiner as being broader in scope than the claim upon which they depend. Claim 81 has been amended to conform to the form of previously amended claim 92, which was not previously rejected under 35 U.S.C. § 112.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

### **Rejections under 35 U.S.C. § 103**

#### **Gordon et al.**

Claims 81-89, 111-114, 119 and 120 were rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' acknowledged state of the art in view of Gordon et al. (U.S. Pat. No. 5,763,332, hereinafter "Gordon"). According to the Final Office Action, Applicants' background discloses the invention substantially as claimed, namely a roll of wet wipes with perforated sheets; and Gordon discloses the desirability of the use of a sodium chloride containing composition on wet wipes. The Examiner argued that it would have been obvious to use the antibacterial composition of the secondary reference to provide a wet wipe with enhanced cleaning properties. Regarding the size of the roll, the Examiner stated that it would have been obvious to adjust the size of the wet wipes to accommodate a particular end use of the wipe and to vary the peel force between the wipes to any specific amount to provide the desired peel properties for a particular end use.

Neither Applicants' background nor Gordon discloses or suggests the elements of Applicants' claimed roll of wet wipes that recite:

a roll having at least 300 linear inches of wet wipes, the wet wipes having a width of not more than about 4.5 inches, wherein the diameter of the roll is at least about 2 inches and no greater than about 5.5 inches  
[claim 81]

or

a roll having a peel force between the wipes in the roll is at least 115 g  
[claim 88]

or

a roll having a peel force between the wipes in the roll is from about 106 g to about 170 g

[claim 89]

In particular, neither Applicants' background nor Gordon make any reference to the claimed dimensions or peel forces for a roll of wet wipes, nor do they provide any suggestion or motivation to modify wet wipes according to claimed sizes or peel forces.

Applicants respectfully point out that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 as a basis for rejection of these claims. In MPEP § 2143, the three basic elements of a valid *prima facie* case of obviousness in view of a reference are presented as:

- 1) Some suggestion or motivation to modify the reference or to combine reference teachings;
- 2) A reasonable expectation of success in the modification or combination; and
- 3) A teaching or suggestion of **all** the claim elements in the reference(s).

The Examiner has not provided Applicants with a reference or a combination of references which teaches or suggests all the elements of Applicants' claims. Although over three hundred documents have been submitted by Applicants in the form of Information Disclosure Statements and have been reviewed by the Examiner, no references have been identified that disclose or suggest e.g., the dimensions set forth in independent claim 81 or the peel forces set forth in dependent claims 88 and 89. Further, the Examiner's assertion that Applicants' background statements qualify as prior art is contrary to the law. In the decision of *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), with reference to background description in a patent application, it is noted that:

That there were other attempts, and various combinations and procedures tried in the past, **does not render obvious** the later successful one ... Further, a patent applicant's statement of the purpose of the work is **not prior art**.  
[Emphasis and ellipsis added]

Notwithstanding misapplication of the Applicants' background discussion as prior art, neither Applicants' background nor Gordon teaches or suggests each and every element of Applicants' claims and the Examiner has failed to provide any other references which would provide the missing claim elements. Instead of citing appropriate references, the Office Action appears to supply claim elements from the Examiner's personal knowledge, including but not limited to elements related to wet roll dimensions, peel forces, etc. As noted in the MPEP 2144.03, with reference to 37 CFR 1.104(d)(2):

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported**, when called for by the applicant, by an affidavit from the examiner. [Emphasis added]

Accordingly, applicants hereby request, under 37 CFR 1.104(d)(2), that the Examiner provide an affidavit in support of the assertions made based on the Examiner's personal knowledge.

The Examiner also has not provided any suggestion or motivation to take a roll of wipes, either as described in a reference or as described in Applicants' background, and to modify the roll to conform to the claims. As noted in MPEP § 2143.01, with reference to *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993):

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art" at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness

without some **objective reason to combine** the teachings of the references. [Bold emphasis added]

Further, in *In re Dow Chemical Co.*, 1531, it is noted that:

Both the suggestion and the reasonable expectation of success must be founded in the prior art, **not in the applicant's disclosure**. [Emphasis added]

The Final Rejection states that it would have been obvious to adjust the size of the wet wipes to accommodate a particular end use of the wipe. However, the Office Action does not provide any particular end use described in a prior art reference that would necessitate or motivate a skilled artisan to modify a roll of wet wipes according to the present claims. Even if we were to accept the Applicants' statements about the prior art as an appropriate basis for a primary reference to a roll of wet wipes, the Examiner has not provided a sufficient motivation to apply the emulsion of Gordon to a roll of wet wipes. Gordon does not disclose a roll of wet wipes and is therefore applied as a secondary reference to provide missing claim elements regarding the wetting composition.

Gordon's wipes are predicated on *not* being wet unless shear is applied. In particular, Gordon discloses wipes that can be prepared in the form of rolls, wherein the wipes comprise an inverse emulsion containing a wetting solution capable of wetting a wipe when subjected to shear pressures sufficient to rupture the emulsion so that the wetting solution can be released. In other words, Gordon discloses an embodiment in which the wetting composition and its contents are shielded from the wipes until the point of use. In contrast, the claims are directed to a roll of wipes fully exposed to a wetting composition and completely wet before use.

Gordon's disclosure would not motivate a skilled artisan to apply its teachings to an already wet roll of wipes. Gordon teaches away from using wet wipes. Gordon's background section discusses prior art wipes kept in a dispenser soaked in a moistening solution having a permanent wet strength such that they are not flushable and teaches that prior art wipes are often too wet to dry the skin and have a cold feel

(see col. 2, lines 38-46). Accordingly, Gordon provides an alternative to wet wipes that confers selective wetting. The prior art of record does not provide a motivation to incorporate additional, selectively releasing wetting agents to an already saturated wet roll. This would only exacerbate the problems identified by Gordon above.

Gordon specifically references the desirability of providing an improved emulsion to the cleaning wipes described in an earlier copending application sharing a common inventor. Gordon's disclosure seeks to reduce the level of emulsion needed to counteract the level of water absorbed by hydrophilic carriers (col. 3, lines 14-31). Obviously, this is not a problem with a wet wipe saturated with a wetting composition both in and around the wipe. Therefore, any motivation to apply Gordon's teachings to wet rolls is not to be found in Gordon.

Given that Gordon's described benefits are inapplicable to wet rolls, hindsight reasoning is required to extrapolate out of Gordon's emulsion the notion that the wetting composition contained therein should substitute with some, yet unspecified wetting composition in a roll of wet wipes for the purpose of providing antibacterial and/or cleaning benefits. However, any such benefits to provide a motivation to combine are not to be found in any prior art of record. The Examiner argues that Gordon discloses the desirability of a sodium chloride containing composition on wet wipes and that it would have been obvious to use the antibacterial composition of the secondary reference on the article to provide a wet wipe with enhanced cleaning properties. However, Gordon's reason for using sodium chloride is not applicable to wipes saturated with a wetting composition. Sodium chloride is used in the internal polar phase of the emulsion as an electrolyte to minimize the tendency of materials present in the lipid phase to also dissolve in the water phase (col. 14, lines 8-15). Accordingly, the skilled artisan would not find any benefit in using sodium chloride in a wetting composition unless there was a need for an emulsion, for which there is insufficient evidence.

Moreover, Gordon is completely silent about any antibacterial compositions and there is nothing to infer from Gordon's disclosure concerning an antibacterial benefit attributed to its disclosed wetting compositions, nor is there any evidence in support of enhanced cleaning benefits to already saturated wet wipes, particularly given Gordon's

negative admonishments about wipes that are too wet. Thus, even if we accept Applicants' background as an appropriate basis for a primary wet roll reference, the disclosure of Gordon et al. fails to provide the necessary suggestion or motivation for modifying a roll of wipes according to the claimed subject matter.

These principles have been upheld in recent decisions of the U.S. Court of Appeals for the Federal Circuit. In the decision of *In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999), the court reversed a rejection under 35 U.S.C. § 103, stating:

Because we do not discern any finding by the Board that there was a **suggestion, teaching, or motivation to combine** the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. [Emphasis added]

Likewise, in the decision of *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), the court reversed another rejection under 35 U.S.C. § 103, stating:

This factual question of motivation is material to patentability, and could not be resolved on **subjective belief** and **unknown authority**. [Emphasis added]

This same decision also addressed the need for substantive evidence rather than general statements of obviousness (*Ibid.*, 1435):

Thus when they [the examiner and the Board] rely on what they assert to be general knowledge to negate patentability, that **knowledge must be articulated and placed on the record**. ... The board **cannot rely on conclusory statements** when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies. [Emphasis and ellipsis added]

Thus, until the Examiner provides appropriate references or affidavits with sufficient evidence of a motivation to modify a roll of wet wipes with the disclosed emulsions containing a wetting solution and of the desirability of making such modifications, a *prima facie* case of obviousness has not been presented. Accordingly, in view of the insufficient teachings reciting and/or or suggestions for combining the claimed elements in view of Applicants' disclosure in the specification, the present claims are not obvious under 35 USC § 103 over Applicants' background and Gordon et al.

**Gordon et al. in view of Nissing et al.**

Claims 90-110, 115-118, 121 and 122 were rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' acknowledged state of the art in view of Gordon et al. 5,763,332 as applied to claims 81-88, 111-114, 119 and 120 above, and further in view of Nissing et al. 6,623,834.

According to the Examiner, Applicants' acknowledged state of art discloses the invention substantially as claimed, namely a roll of wet wipes with perforated sheets; Gordon discloses the desirability of the use of a sodium chloride containing composition on wet wipes; and Nissing discloses the desirability of providing transverse grooves in wet wipe material to aid in cleaning surfaces. Given the reasons for Gordon et al. failing to provide the necessary suggestion or motivation for modifying a roll of wipes as described above, Nissing cannot render the rejected claims as being obvious. This is particularly the case because Nissing doesn't cure the fundamental problem concerning application of Gordon's wetting composition to a roll of wet wipes.

Accordingly, Applicants respectfully request that this rejection be withdrawn.



## **Double Patenting**

### **Claim 41 of copending Application No. 10/664,342**

Claims 81-87, 101, 102, 104, 111-114, 119 and 120 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 41 of copending Application No. 10/664,342. Claims 90-98, 106, 107, 109, 115-118, 121 and 122 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 41 of copending Application No. 10/664,342 in view of Nissing et al. ('834).

As stated in Applicants' August 3, 2005 response, at the time the invention of the instant application was made, the invention of the instant application, and the invention in Application No. 10/664,342 were either owned by Kimberly-Clark Worldwide, Inc. or subject to an obligation of assignment to Kimberly-Clark Worldwide, Inc. (See Reel/Frame No. 11784/407 for '631 and '352 patents and Reel/Frame Nos. 12318/486, 12318/502, and 12749/27 for '262 patent). The Examiner was reminded that if the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the Examiner is instructed to withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. MPEP 804 (I)(B).

The Examiner's statement that Applicant's arguments have been considered but are not deemed persuasive for the reasons of record requires clarification, since the reasons of record provided by the Examiner fail to address the Applicants' arguments.

## **Conclusion**

In conclusion, all of the grounds raised in the outstanding Office Action for rejecting the application are believed to be overcome or rendered moot based on the remarks and the amendment above. Thus, it is respectfully submitted that all of the presently presented claims are in form for allowance, and such action is requested in due course. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Brunovskis", written over a horizontal line.

Peter Brunovskis  
Registration No. 52,441  
Agent for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200